

REMARKS***Summary of the Response***

By the present amendment, claim 15 has been amended. Applicant submits that no new matter has been added by this amendment. Support for the amendment may be found, for example, at least in Figure 1. Applicant submits that the amendment to claim 15 was not made to overcome any applied prior art. As such, Applicant submits that any new rejection would not be necessitated by the above amendment. Accordingly, claims 15 – 34 remain pending and under consideration by the Examiner.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected previously presented claims 15, 17, 19, 28 – 30, 32 and 33 over the art of record and has rejected previously presented claims 15 – 32 for being indefinite. By the present amendment and remarks, Applicant submits that all the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Information Disclosure Statement

Applicant appreciates the Examiner's indication that the Information Disclosure Statement filed May 30, 2006 has been considered. While Applicant notes that each individual reference on the IDS has not been initialed, the Examiner has indicated that "All References Considered Except Where Lined Through," and no references have been lined through.

Allowable Subject Matter

Applicant appreciates the Examiner's indication that claim 34 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, Applicant appreciates the Examiner's indication that claims 16, 18, 21 – 27 and 31¹ would be allowable if rewritten to overcome the 112, 2nd paragraph rejections and in independent form including all of the limitations of the base claim and any intervening claims.

However, Applicant respectfully submits that all of the claims are allowable for the following reasons.

Traversal of Rejection under 35 U.S.C. § 112, 2nd Paragraph

Applicant traverses the rejection of claims 15 – 32 under 35 U.S.C. § 112, 2nd paragraph for being indefinite. Specifically, the Examiner asserted it was “not clear which rubber band(s), the propelling rubber bands and/or the tensioning rubber bands, are guided by the pulleys.”

By the present amendment, Applicant has amended claim 15 to recite that the propelling rubber bands are guided by the pulleys. As set forth above, Applicant submits that this is clearly shown, for example, at least in Figure 1. Thus, Applicant submits that claim 15 is not indefinite.

Accordingly, Applicant respectfully requests the rejection of claims 15 – 32 be reconsidered and withdrawn.

¹ Applicant notes that claim 20 is not rejected with a prior art rejection. Thus, Applicant assumes the Examiner intended to indicate that claim 20 would also be allowable if the §112, 2nd paragraph rejections were overcome.
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Traversal of Rejection under 35 U.S.C. § 102(b)

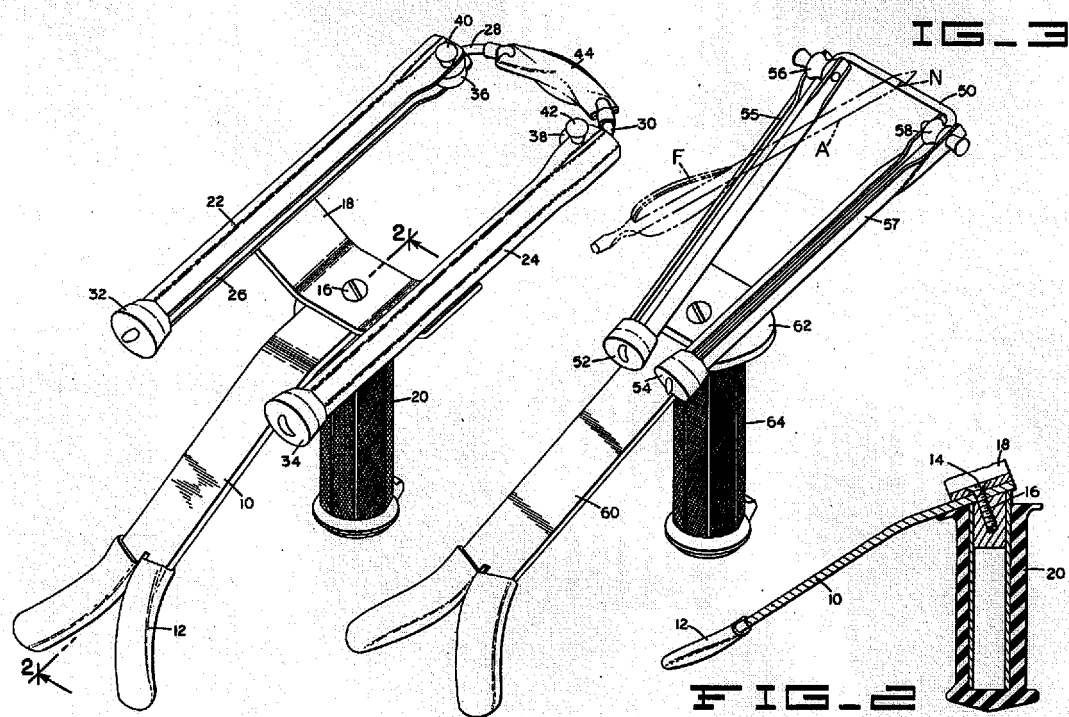
Applicant traverses the rejection of claims 15, 17, 19, 28 – 30, 32 and 33 under 35 U.S.C. § 102(b) as being anticipated by US 4,458,658 issued to Blair et al. [hereinafter BLAIR]. Applicant submits that BLAIR does not disclose each of the features of the present invention. Additionally, Applicant submits the Examiner has not addressed each feature of the rejected claims, and thus, has not set forth a complete action.

Independent Claim 15

The present invention generally relates to a spear gun for propelling a shaft. More specifically, claim 15 recites, in pertinent part:

... a barrel extending to a head;
propelling rubber bands and tensioning rubber bands; and
pulleys, located at the head, arranged to guide the propelling
rubber bands to pass from a top of the barrel to an underside of the barrel,
wherein the shaft is propelled along an entire length of the barrel.

BLAIR discloses a sling shot. More specifically, BLAIR discloses a sling shot formed by two laterally-spaced guide members secured on a base member to project generally in the direction of propulsion and to encompass a resilient member extending through the guide members and across the forward extremities thereof so as to engage a shot, arrow, or other projectile. Applicant has reproduced Figures 1 – 3 of BLAIR below.



In addressing claims 15, 17, 19, 28 – 30, 32 and 33, the Examiner states:

Blair shows a gun for propelling a shaft (Figure 3), including a barrel 60; rubber bands 50, one side of which may be a “propelling rubber band”, and the other side of which may be a “tensioning rubber band”; and pulleys 56, 58, which guide the rubber bands from a top of the barrel to the underside of the barrel.

Applicant respectfully disagrees.

Applicant submits BLAIR does not disclose each of the features of the present invention. For example, Applicant submits BLAIR does not disclose: 1) propelling rubber bands and tensioning rubber bands; or 2) pulleys, located at the head of the barrel, arranged to guide the propelling rubber bands to pass from a top of the barrel to an underside of the barrel, as recited in claim 15.

No Disclosure of Propelling Rubber Band And Tensioning Rubber Band

Applicant submits BLAIR does not disclose propelling rubber bands and tensioning rubber bands, as recited in claim 15. In addressing the recited propelling rubber bands and tensioning rubber bands, the Examiner asserts BLAIR discloses rubber bands 50. Applicant disagrees. As described with reference to Figure 3, BLAIR discloses element 50 is “a single piece of resilient tubing . . .” (see column 4, line 27). As BLAIR unambiguously describes element 50 as a single rubber band, Applicant submits that element 50 cannot arguably be construed as the recited propelling rubber bands *and* tensioning rubber bands, as asserted by the Examiner.

While Applicant acknowledges that the embodiment shown in Figure 1 of BLAIR, includes two pieces of resilient tubing 28, 30 connected by a pouch 44 for containing the shot, the Examiner has not asserted this embodiment as anticipatory. Moreover, Applicant submits there is no disclosure associated with this embodiment that would arguably support an assertion that the bands (28, 30) of BLAIR would be reasonably construed as propelling rubber bands and tensioning rubber bands, within the context of the pending claims.

In addressing these features with element 50 of the embodiment of Figure 3 of BLAIR, the Examiner asserts that one side of which may be a “propelling rubber band”, and the other side of which may be a “tensioning rubber band”. Applicant disagrees and notes the Examiner has not identified any disclosure in support of his assertion. In particular, there is no disclosure as to how or why one ordinarily skilled in the art would construe a single band as both a propelling rubber band and a tensioning rubber band.

In this regard, the specification sets forth that the propelling rubber band and the tensioning rubber band are distinct elements. However, in asserting the single piece of resilient

tubing 50 constitutes the recited propelling rubber band and the tensioning rubber band, the Examiner improperly divides a single element of BLAIR into two recited elements of the instant invention.

Moreover, to the extent that the Examiner believes that the two resilient tubes of Figure 1 may constitute the recited propelling rubber band and the tensioning rubber band, Applicant submits these two resilient tubes are left and right equivalents of the same element. That is, resilient tube 28 is the left-side rubber band and resilient tube 30 is the right-side rubber band. However, as the resilient tubes 28 and 30 are left and right equivalents of the same element, Applicant submits the resilient tubes 28 and 30 cannot reasonably be construed as the recited propelling rubber band and the recited tensioning rubber band.

Thus, for at least these reasons, Applicant submits BLAIR does not disclose propelling rubber bands and tensioning rubber bands, as recited in claim 15.

No Disclosure of Pulleys, Located at Head of Barrel, Arranged to Guide Propelling Rubber Bands to Pass from Top of Barrel to Underside of Barrel

Applicant submits that BLAIR does not disclose pulleys, located at the head of the barrel, arranged to guide the propelling rubber bands to pass from a top of the barrel to an underside of the barrel, as recited in claim 15. In addressing claim 15, the Examiner designates element 60 of BLAIR as the recited barrel.

With this in mind, Applicant submits that BLAIR does not disclose pulleys located at the head of the barrel. That is, while acknowledging that BLAIR discloses pulleys 56 and 58, Applicant submits that the pulleys are positioned on the ends of respective left and right guide members 55 and 57 and are located above and beyond the extent of supporting rigid strap 60,

which the Examiner designated as the recited barrel, and BLAIR describes as a base to form an arm support. As such, Applicant submits that BLAIR does not disclose pulleys located at the head of the barrel, as recited in claim 15.

Additionally, Applicant submits that BLAIR does not disclose pulleys arranged to guide the propelling rubber bands to pass from a top of the barrel to an underside of the barrel. That is, contrary to the Examiner's assertion, as shown in Figure 3, the pulleys 56 and 58 are not arranged to guide the resilient tubing 50 to pass from a top of the barrel 60 to an underside of the barrel 60. Rather, with BLAIR, none of the resilient tubing passes to an underside of the Examiner-designated barrel 60. Thus, Applicant submits BLAIR does not disclose pulleys arranged to guide the propelling rubber bands to pass from a top of the barrel to an underside of the barrel, as recited in claim 15.

Thus, for at least these reasons, Applicant submits BLAIR does not disclose pulleys, located at the head of the barrel, arranged to guide the propelling rubber bands to pass from a top of the barrel to an underside of the barrel, as recited in claim 15.

All Claim Features Not Addressed

Applicant submits the Examiner did not address each of the features of claim 15. Thus, as discussed further below, Applicant submits the Examiner has not set forth a clear record or a complete action.

For example, Applicant submits the Examiner did not address "wherein the shaft is propelled along an entire length of the barrel," as recited in claim 15. Moreover, Applicant submits that BLAIR does not disclose the shaft is propelled along an entire length of the barrel. As discussed above, in addressing claim 15, the Examiner designated element 60 of BLAIR as

the recited barrel. Figure 2 of BLAIR (reproduced above) shows a side view of the BLAIR sling shot, including the supporting rigid strap 60, which the Examiner designated as the recited barrel.

As disclosed in BLAIR, the supporting rigid strap 10 functions to provide additional support by contacting the user's forearm. As shown in Figure 2, the supporting rigid strap 10 (or 60 in the second embodiment) projects at a downward angle from the top of the handle rearward in order to make contact with a users forearm. Moreover, as can be observed in Figure 2, the supporting rigid strap 10 is angled more steeply towards its rear. As such, Applicant submits that the Examiner-designated barrel is not structured for a shaft to be propelled along an entire length of the barrel, as recited in claim 15.

Thus, for at least these reasons, Applicant respectfully submits BLAIR does not disclose each of the features of claim 15.

Independent Claim 33

Independent claim 33 recites, in pertinent part:

A method of using a spear gun, comprising:
loading a shaft onto a top of a spear gun barrel;
loading at least one propelling rubber band, guided from an underside of the barrel to a top of the barrel, onto the shaft; and
propelling the shaft along an entire length of the barrel.

Applicant submits BLAIR does not disclose each feature of claim 33. For example, Applicant submits BLAIR does not disclose: 1) loading a shaft onto a top of a spear gun barrel; 2) loading at least one propelling rubber band, guided from an underside of the barrel to a top of the barrel, onto the shaft; or 3) propelling the shaft along an entire length of the barrel, as recited in claim 33. Additionally, Applicant submits the Examiner has not specifically addressed recited features of claim 33.

No Disclosure of Spear Gun Barrel or Loading a Shaft onto a Top of a Spear Gun Barrel

Applicant submits BLAIR does not disclose a spear gun barrel or loading a shaft onto a top of a spear gun barrel, as recited in claim 33. As discussed above, the Examiner has designated strap 60 of BLAIR as the recited spear gun barrel. However, for the reasons set forth above, Applicant submits that strap 60 of BLAIR cannot reasonably be construed as a spear gun barrel, within the context of the pending claims. That is, Applicant submits that the Examiner-designated barrel is not structured for a shaft to be propelled there along. As such, Applicant submits that strap 60 of BLAIR cannot reasonably be asserted as the recited spear gun barrel.

Moreover, Applicant submits that BLAIR does not disclose loading a shaft onto a top of a spear gun barrel, as recited in claim 33. Applicant notes that, in addressing claim 33, the Examiner did not specifically address this feature. Thus, as discussed further below, Applicant submits the Examiner has not set forth a clear record or a complete action. Furthermore, Applicant submits that BLAIR is completely silent as to loading a shaft onto a top of the rigid strap 60, which the Examiner designated as the recited barrel.

Additionally, a close inspection of Figure 3 reveals that, were a user of the BLAIR device to load a shaft onto a top of the Examiner-designated barrel 60, the stops 52 and 54 would interfere with the feathers F of the shaft A, as the feathers pass between the stops 52 and 54, thus precluding the strap 60 as functioning as the recited barrel. Moreover, a supporting bracket 62 is fastened above handle 64 with the Examiner-designated barrel 60 arranged there between. As such, the supporting bracket covers a portion of the Examiner-designated barrel, and effectively precludes the strap from acting as a the recited barrel.

Thus, for at least these reasons, Applicant submits BLAIR does not disclose a spear gun barrel or loading a shaft onto a top of a spear gun barrel, as recited in claim 33

No Disclosure of Loading Propelling Rubber Band, Guided from Underside of Barrel to Top of Barrel, onto Shaft

Applicant submits BLAIR does not disclose loading at least one propelling rubber band, guided from an underside of the barrel to a top of the barrel, onto the shaft, as recited in claim 33. As discussed above with regard to claim 15, the Examiner has designated element 60 in Figure 3 as the recited barrel. Thus, as discussed above, Applicant submits that the resilient tube of BLAIR is connected to the ends of guide members 55 and 57 and these guide members are located above strap 60. Thus, a careful review of Figure 3 reveals that band 50 is situated completely above the Examiner-designated barrel, and as such, is not guided from an underside of the barrel, as recited in claim 33.

Thus, Applicant submits BLAIR does not disclose loading at least one propelling rubber band, guided from an underside of the barrel to a top of the barrel, onto the shaft, as recited in claim 33.

No Disclosure of Propelling Shaft Along an Entire Length of the Barrel

Applicant submits BLAIR does not disclose propelling the shaft along an entire length of the barrel, as recited in claim 33. As discussed above, the Examiner has designated element 60 in Figure 3 as the recited barrel. Additionally, as discussed above, the Examiner-designated barrel generally corresponds to supporting rigid strap 10 in Figures 1 and 2, which functions to provide additional support by contacting the user's forearm. However, due to the downward projection

of the supporting rigid strap 10, which includes different angled regions, Applicant submits the Examiner-designated barrel is not structured such that a shaft could be propelled along an entire length of the barrel.

Moreover, as shown in Figure 3, a supporting bracket 62 is fastened above handle 64 with the Examiner-designated barrel 60 arranged there between. As such, the supporting bracket covers a portion of the Examiner-designated barrel. In view of the above, Applicant submits BLAIR cannot disclose propelling the shaft along an entire length of the barrel, as recited in claim 33, as a portion of the Examiner-designated barrel is obscured from possible contact with the shaft.

Thus, for at least these reasons, Applicant submits that BLAIR does not disclose propelling the shaft along an entire length of the barrel, as recited in claim 33.

Therefore, for at least these reasons, Applicant respectfully submits BLAIR does not disclose each of the features of claim 33.

Dependent Claims 17, 19, 28 – 30 and 32

Applicant respectfully submits that claims 17, 19, 28 – 30 and 32 which depend from allowable independent claim 19, are allowable at least based upon the allowability of the independent claim, and further because these claims recite additional subject matter to further define the instant invention.

Claim 19

Additionally, Applicant submits BLAIR does not disclose each of the features of claim 19. Applicant notes that, while the Examiner stated claim 19 was anticipated by BLAIR, the

Examiner did not specifically address the features of claim 19. As such, as discussed further below, Applicant submits the Examiner has not presented a clear record or a complete action.

Moreover, Applicant submits BLAIR does not disclose the features of claim 19. Claim 19 recites, in pertinent part, "wherein the pulleys are faired to allow a release wire to glide through the spear gun." Applicant submits BLAIR is completely silent as to any pulleys being faired.

Thus, Applicant submits BLAIR does not disclose wherein the pulleys are faired to allow a release wire to glide through the spear gun, as recited in claim 19.

Claims 28 - 30

With regard to claims 28 – 30 , Applicant notes that, while the Examiner stated claims 28 – 30 were anticipated by BLAIR, the Examiner did not specifically address the features of claims 28 – 30. As such, as discussed further below, Applicant submits the Examiner has not presented a clear record or a complete action.

Accordingly, for at least these reasons, Applicant respectfully requests the rejection of claims 15, 17, 19, 28 – 30, 32 and 33 be reconsidered and withdrawn.

Complete Action not Provided

Applicants respectfully submit that the Examiner did not provide a complete action, and as such, Applicants submit that the next action should not be a final action. The Examiner is reminded of the guidance provided by 37 C.F.R. § 1.104(a)(1) regarding the Nature of Examination (emphasis added):

On taking up an application for examination . . . the examiner shall make a thorough study thereof and shall make a thorough investigation of the

available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

Furthermore, the Examiner is respectfully reminded of the guidance provided by MPEP § 2143.03 regarding All Claim Limitations Must be Taught or Suggested, which states (emphasis added):

. . . [a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.

As discussed above, Applicant submits the Examiner did not address some of the features of claims 15 and 33 as claimed. For example, with regard to claim 15, the Examiner never addressed “wherein the shaft is propelled along an entire length of the barrel.” With regard to claim 33, the Examiner never addressed “loading a shaft onto a top of a spear gun barrel” or “propelling the shaft along an entire length of the barrel.” Additionally, the Examiner never specifically addressed any of the features of claims 19 and 28 – 30.

For these reasons, Applicant submits that a clear issue was not developed between the Examiner and Applicant. As such, Applicant submits that the next Office Action, which should clarify this issue, *cannot* be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicant respectfully submits the Examiner may not make the next action final, as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant".

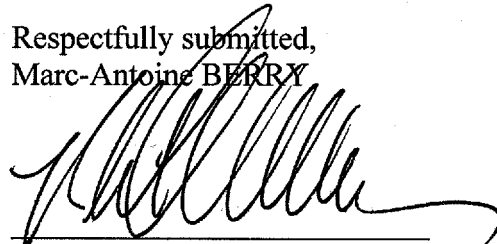
CONCLUSION

In view of the foregoing amendment and remarks, it is submitted that the reference of record does not anticipate Applicant's invention, as recited in claims 15, 17, 19, 28 – 30, 32 and 33. The applied reference of record has been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to charge and fees necessary for the consideration of this paper to deposit account 19-0089.

Respectfully submitted,
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